

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Resnick, et al.	§	Confirmation No.: 6113
	§	
Application No.: 09/734,988	§	Group Art Unit: 3692
	§	
Filed: December 11, 2000	§	Examiner: Elda G. Milef
	§	
For: Electronic Payment System Utilizing Intermediary Account	§	Attorney Docket No.: 39048.21

Commissioner for Patents
Mail Stop Amendment [AF]
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

I. INTRODUCTION

The present paper is being filed under the Official Gazette Notice of July 12, 2005, and in response to the Final Office action mailed September 2, 2008, and the Advisory Action mailed November 14, 2008, in connection with the above-noted application. A Notice of Appeal with the proper fee is being filed concurrently with this paper. It is assumed that no additional fees are required, but if any additional fees are required, the Commissioner is hereby authorized to charge any fees, including those for any extensions of time, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

II. REASONS

In the Final Office Action mailed September 2, 2008, independent claim 40 was rejected under 35 U.S.C. §102(e) over U.S. Patent No. 6,000,608 to Dorf (hereinafter referred to as "Dorf"). Further, independent claims 35 and 48 were rejected under 35 U.S.C. §103(a) over Dorf in view of U.S. Patent No. 5,704,046 to Hogan (hereinafter referred to as "Hogan"). Applicants submit that there is clear error with respect to the rejection of independent claims 35, 40, and 48, and all claims which depend therefrom. Thus, Applicants respectfully traverse these rejections.

A. Rejection of Independent Claim 40 under 35 U.S.C. § 102(e)

Applicants submit that there is clear error with respect to the rejection of independent claim 40 under 35 U.S.C. §102(e) over Dorf. Applicants submit that the rejection of independent claim 40 is clear error because Dorf clearly fails to teach an intermediary account number," and "associating an account identifier that represents an end-user's prepaid account maintained by a telecommunications provider with an intermediary account number," as recited in claim 40. Applicants respectfully traverse this rejection and submit that the Examiner has committed at least one clear error in rejecting independent claim 40. As a result, for the reasons set forth in detail below, Dorf is defective in anticipating claim 40. Further, all claims which depend from claim 40 include at least

the elements of claim 40 that have been presented above, and therefore are also allowable over Dorf for at least the same reasons set forth below.

Applicants' independent claim 40 recites a method for effecting payment for telephone services that includes associating an intermediary account number with an account identifier the represents an end-user's prepaid account maintained by a telecommunications provider. The method further includes storing the association in a database coupled to a central payment processor, wherein the association includes information that allows the central payment processor to identify the end-user's prepaid account when presented with the intermediary account identifier.

1. Dorf Teaches:

Applicants submit that Dorf does not teach or disclose the intermediary account limitations recited in independent claim 40. More particularly, Dorf teaches (in the sections cited by the Examiner – columns 7 and 8) a card system where a user presents a card 101 at a retailer and indicates the desired purchase amount, as shown in Figure 2. The retailer swipes the card 101 through a POS device 105, which communicates the card data, *i.e.*, the card identification number read from the card's magnetic strip 106, to a bank processor 208. The bank processor 208 communicates the card data (including the card identification number) over the debit network 107 to the sponsoring bank processor 102, which acts as a link between the debit network 107 and the processing hub 103.

Once the card data (including the card identification number) is received at the processing hub 103, the processing hub 103 recognizes the card identification number as representing a particular prepaid phone card issuer, and forwards the card identification number to a specific issuer hub 104 that is maintained by the corresponding prepaid phone card issuer. The issuer hub 104 activates a record in a phone card database having the same identification number as the card 101, and a value field in this record is updated to reflect the purchase amount. The issuer hub 104 then returns an authorization number back along the same path to the POS device 105, and the user may then use the authorization number to activate the purchased amount of time.

Please refer to Figure 1 below for an illustration of the process taught by Dorf:

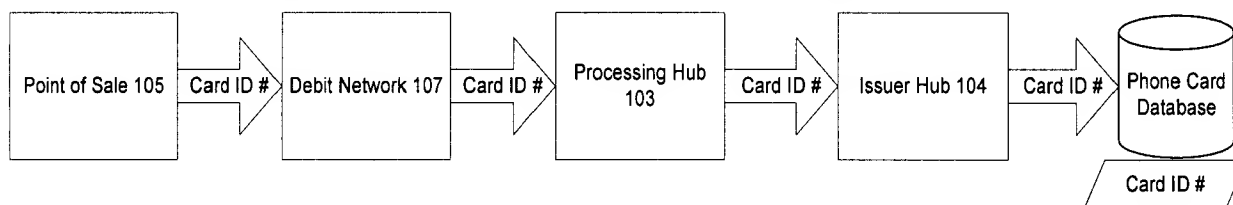


FIGURE 1

2. Distinctions:

The Final Office Action, at pages 4 and 5, alleges that the prepaid card identification number of Dorf teaches the “intermediary account number” recited in claim 40. However, the prepaid card identification number in Dorf is the same number that is sent from the POS device 105 to the bank processor 208 and the processing hub 103 (Dorf, col. 7, ll. 3-5). Further, the prepaid card identification number in Dorf is the same number that is sent from the processing hub 103 to the issuer hub 104 (Dorf, col. 7, ll. 9-13, 15-18). Thus, the prepaid card

identification number taught by Dorf is the only number used throughout the entire process, as shown above in Figure 1 of this document. This is disclosed in Dorf as follows: “When the issuer hub 104 receives the data from the processing hub 103, **it activates the record in the phone card database 204 having the same identification number as the card 101**” (Dorf, col. 7, ll. 15-18, **emphasis added**). At least for the reason that the same prepaid card identification number is used throughout the process taught by Dorf, Dorf fails to teach an “intermediary account number,” as recited in claim 40.

Further, the present application teaches that the intermediary account is different from the end-user account as follows: “The card user makes a payment to the merchant, for example in cash, and presents the user’s [intermediary] account identifier. This [intermediary account identifier] refers to the intermediary account which is maintained on the pre-payment processor 40. **[The intermediary account] is not the same as the end-user account which would be maintained at the carrier’s prepaid platform 112.**” (Application, ¶25, **emphasis added**). Accordingly, because the intermediary account is different from the end-user account, an “association” must be made between the intermediary account identifier and the end-user’s prepaid account identifier. Further, the payment processor must look up the associated end-user account number and send it to the carrier pre-paid platform..

Please refer to Figure 2 below for an illustration of the process taught by the present Application, which requires an association between the intermediary account number and the end-user account number:

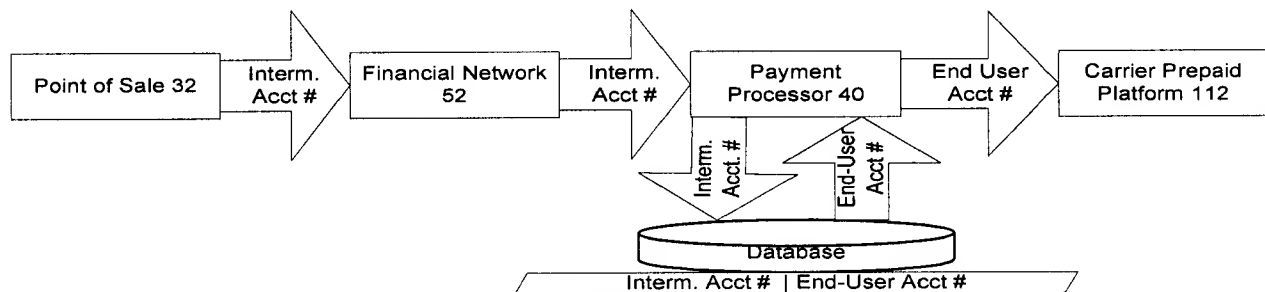


FIGURE 2

As shown in Figure 2 above, the payment processor sends the intermediary account number to the database, and retrieves the end-user account number that is associated with the intermediary account number. However, in the system taught by Dorf, there is no need to “store the association in a database coupled to a central payment processor, wherein the association includes information that allows the central payment processor to identify the end-user’s prepaid account when presented with the account identifier . . . [, and look] up the intermediary account number associated with the account identifier,” as recited in claim 40, because the system of Dorf uses the same prepaid card identification number through the process.

Thus, Dorf fails to teach an “intermediary account number” and “associating an account identifier that represents an end-user’s prepaid account maintained by a telecommunications provider with an intermediary account number,” as recited in claim 40. Therefore, Applicants respectfully submit that Dorf clearly fails to teach

or show each and every limitation recited in independent claim 40 as amended, and as such, the rejection of claim 40 under 35 U.S.C. §102(e) over Dorf, and all claims depending therefrom, is respectfully requested.

B. Rejections of Independent Claims 35 and 48 under 35 U.S.C. § 103(a)

The Applicants submit that there is clear error with respect to the rejection of independent claims 35 and 48 under 35 U.S.C. §103(a) over Dorf in view of U.S. Patent No. 5,704,046 to Hogan (hereinafter referred to as “Hogan”). The Applicants submit that the rejection of claims 35, 48, and all claims which depend therefrom are deficient because both Dorf and Hogan clearly fail to teach or suggest an “intermediary account” or an “intermediary account number.”

The Final Office Action asserts that Dorf teaches each and every limitation recited in the rejected claims, except for the limitation of “wherein the intermediary account number is different from the end-user account identifier.” However, the Office Action cited Hogan as teaching this limitation, and concluded that it would have been obvious for one of ordinary skill in the art to have combined the teachings of the cited references to create the invention recited in the rejected claims. Applicants respectfully traverse the rejection of independent claims 35, 48, and all claims which depend therefrom, and submit that each of the rejected claims recites limitations that are not taught, shown, or even suggested by the cited prior art, when taken alone or in combination.

1. Dorf in view of Hogan fails to teach, show, or suggest an “intermediary account number”

Claims 35 and 48 each expressly recite an “intermediary account number.” Dorf fails to teach an intermediary account number, as discussed above. Hogan teaches a sub-account number at the following cited portions: “the account number identifies the account associated with card 100 for billing purposes. The card number acts as a sub-account number identifying additional cards issued under the same account number. Thus, for example a spouse may possess an associated financial card having the same account number but a different card number” (Hogan, col. 5, line 66 to col. 6, line 5).

In contrast, paragraph 23 of the present application states that the intermediary account identifier “refers to the intermediary account which is maintained on the pre-payment processor 40. It is not the same as the end-user account which would be maintained at the carrier's prepaid platform 112” (emphasis added). A careful reading of the cited portions does not support the Office Action's conclusion that Hogan teaches an “intermediary account number” as recited in claims 35 and 48.

Even when combined, Dorf and Hogan merely teach a prepaid card identification number, which may be a sub-account number, that is the same number that is received at a processing hub. Thus, even when combined, Dorf and Hogan fail to teach an “intermediary account number,” as recited in claims 35 and 48.

Accordingly, neither Dorf nor Hogan, whether taken alone or in combination, teaches, shows, or even suggests an “intermediary account number.” It is submitted that, in the present case, the Office Action has not factually supported a prima facie case of obviousness for this mutually exclusive reason. Thus, the rejection of claims 35 and 48 under 35 U.S.C. §103(a) over Dorf in view of Hogan is based on clear error. Further, all claims which depend from claims 35 and 48 include at least the elements of claims 35 and 48 respectively. Therefore, all

claims which depend from claims 35 and 48 are also allowable over Dorf in view of Hogan for at least the same reasons as set forth above.

2. Prior art that teaches away from the claimed invention cannot be used to establish obviousness

KSR maintained the long-standing principal that "when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious." *KSR* at 1740. In the present case, the Dorf reference clearly teaches away from "a database associating each of a plurality of intermediary account numbers with at least one corresponding end-user account number . . . wherein the intermediary account number is different from the end-user account number," as recited in claim 30, because Dorf teaches the use of only one account identification number throughout the entire processing sequence. Please note that the specification of Dorf expressly teaches using the same number, as discussed above on page 3, line 6.

Thus, at least for this reason alone, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of independent claims 35 and 48 under 35 U.S.C. §103 should be withdrawn. Further, all claims which depend from claims 35 and 48 include at least the elements of claims 35 and 48 respectively. Therefore, all claims which depend from claims 35 and 48 are also allowable over claims Dorf in view of Hogan for at least the same reasons as set forth above.

III. Conclusion

In view of the fact that there is at least one clear error in the rejections, as demonstrated above, it is apparent that the rejections of the pending claims under 35 U.S.C. §102(e) and 35 U.S.C. §103(a) are not supported by the cited references and should therefore be withdrawn. Accordingly, all of the pending the claims in the application being in condition for allowance, such action is respectfully requested.

Respectfully submitted,

Lam Nguyen, Registration No. 62433

N. Alexander Nolte
Registration No. 45,689

Dated: December 2, 2008

HAYNES AND BOONE, LLP
Customer No.: 27683
Telephone: 713/547-2156
Facsimile: 214/200-0853
Client Matter No.: 39048.21

I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via EFS-Web on the following date.

Date 12/2/08

Stacy Lanier
Stacy Lanier